



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Bryan

Serial No. 9/871349

Filed May 31, 2001

For: **Game Board and Game Having a
Touring Band Theme**

Attorney Docket No. 4822-001

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) Vishu Mendiratta
) Examiner
) Group 3711
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The present appeal brief is filed in triplicate pursuant to 37 C.F.R. § 1.192. Applicant also encloses Check No. 9196 in the amount of \$160.00 as required by 37 C.F.R. § 1.17(c). Applicant is a small entity. If additional fees are required, the Commissioner is authorized to charge Deposit Account 18-1167.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is Paul J. Bryan, whose address is 7701 Long Street Drive, Raleigh, North Carolina 27615.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

(3) STATUS OF CLAIMS

A total of fifteen (15) claims were presented for examination. Claim 12 was cancelled during the examination process, resulting in a total of fourteen (14) claims, numbered 1-11 and 13-15, still pending in the application. The Examiner has allowed claims 1-10 and 15, objected to claim 13, and rejected claims 11 and 14. Accordingly, Applicant appeals the rejection of claims 11 and 14.

(4) STATUS OF AMENDMENTS

All amendments have been entered.

(5) SUMMARY OF INVENTION

The present invention discloses a game board and game with a touring band theme. The game board includes a starting point, i.e., a parking lot, connected to an ending point, i.e., a stage, by a network of paths that wind around the game board (spec., pgs. 3 – 4, Figure 1). At least one die, a plurality of tokens, a money supply, and at least two decks of cards are included with the game board (spec., pg. 6). As described on page 5 of the specification, a first deck of cards comprises “Consequence” cards and a second deck of cards comprises “Band Member” cards. Each “Consequence” card includes a consequence (or requirement) for the player drawing the “Consequence” card. Exemplary “Consequence” cards are listed on pages 7-11 of the specification. The deck of “Band Member” cards include a plurality of sub-groups of cards, where each sub-group of cards represents a specific band and where each card in each sub-group represents a band member of that band (spec., page 11). As an example, assume that one of the

sub-groups in the group of "Band Member" cards represents The Beatles. In this example, the Beatles sub-group would include four cards, one card for each of Paul McCartney, John Lennon, Ringo Starr, and George Harrison.

One object of the game is to arrive at the stage with a predetermined number of "Band Member" cards, all from the same group or band (spec., pg. 11). Generally, each player begins with a token, five randomly selected "Band Member" cards, and an initial money supply (spec., pg. 12). Each player advances from the starting point to the stage by rolling the dice and moving the specified number of spaces. A player draws a "Consequence" card only when the player lands on one of the "Consequence" spaces scattered throughout the network of paths (spec., pg. 12). "Band Equipment" card(s) may be purchased only when a player passes the "Pawn Shop" (spec., pg. 13). "Band Member" cards are acquired, traded, and/or discarded throughout the game, as described on pages 12-14 of the specification. For example, "Band Member" cards may be acquired when a player lands on the "Rave" space (spec., pg. 13) and/or when directed by a "Consequence" card (spec., pgs. 7-11). In order to be declared a winner a player must arrive at the performing stage with a predetermined number of "Band Member" cards that represent one band and members of that band.

(6) ISSUES

Whether claims 11 and 14 are anticipated under 35 U.S.C. §102(b) over U.S. Patent No. 4,998,736 to Elrod (hereinafter "Elrod").

(7) GROUPING OF CLAIMS

Group I - Claim 11

Group II - Claim 14

(8) ARGUMENT

A. The Law of Anticipation

Anticipation under 35 U.S.C. §102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). That is, each and every element or limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

In determining if a claim is anticipated, it is fundamental that the claim first be correctly construed. That is, the scope and meaning of each contested limitation must be determined. *Gechter* at 1457; *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). Thereafter, corresponding elements of the allegedly anticipating reference are identified. *Lindemann* at 1458. In the end, there can be no anticipation unless each and every element and limitation of the claimed invention, as properly construed, is found in the single prior art reference.

B. Claim 11 is not anticipated by Elrod

Claim 11 is as follows:

A game board and game comprising: a game board having a performing stage and a network of paths including a plurality of paths that lead to the performing stage; a series of tokens for being advanced from a starting point along paths along the network of

paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include “Consequence” cards that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards are “Band Member” cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members (emphasis added).

1. The Examiner has misinterpreted claim 11.

As stated by the Examiner on page 2 of the Final Office Action dated 18 December 2002, the “ ‘Band-member card group representing a band and members of band’ is being interpreted as a rule for playing and does not add any weight to the apparatus as claimed.” The Examiner goes on to say that the “intended use of an apparatus does not add any limitation to the apparatus in the claim. Accordingly, the recitation of the object of the game carries little weight towards the claimed game.”

First, it is important to appreciate that the Examiner, in taking the position that he has taken, acknowledges that the Elrod reference does not show the "Band Member" card limitation. That is important because, of course, to anticipate, the reference must show each and every

element and limitation of the claim. Faced with this, the Examiner has had to find a rationale for ignoring a material and important limitation of the claim. It is worth noting that the rationale is not that the limitation recites a new use for an old product. Rather, the Examiner takes the position that Applicant, in claim 11, in defining the "Band Member" card limitation has done nothing more than state a rule of the game. As discussed below, that is error. There is no rule stated in claim 11. Claim 11 defines Applicant's invention - not a rule of the game.

The Examiner has misinterpreted the "Band Member" cards limitation of claim 11. Claim 11 recites that the second deck of cards are "Band Member" cards that "include a plurality of groups of cards with each group of cards representing a band and the members of a band." This language clearly defines the structure of the "Band Member" cards. While Applicant acknowledges that the actual acquisition of "Band Member" cards, as described on page 2 of the instant application, is governed by the rules of the game, nothing in the specification or in claim 11 discloses or suggests that the cards themselves define the rules of the game, as suggested by the Examiner. Again, nothing in claim 11 or the specification supports the Examiner's interpretation of the "Band Member" card limitation.

Thus, the interpretation is wrong and because the interpretation is wrong the entire Section §102 analysis is flawed. The Examiner's rejection of claim 11 based on this interpretation must be reversed.

A close review of the band member card limitation in claim 11 reveals that the Applicant has properly claimed the subject matter of his invention. A material and important element of the game and game apparatus disclosed and claimed is indeed the "Band Member" cards. It should be stressed that the "Band Member" card limitation is simply not a recitation of a deck of "Band Member" cards. The claim goes further. The claim particularly provides that not only is

the second deck of cards "Band Member" cards, but that the "Band Member" cards includes a plurality of groups of cards. Then the claim goes on to say that each group of "Band Member" cards represents a band and the members of the band. Here Applicant has fully complied with Section 112 in particularly pointing out and distinctly claiming his invention. The recitation and description of the "Band Member" card element of this invention is as clear as it can be.

Because of the very nature of Applicant's invention, claim 11 specifically describes the "Band Member" cards, and in reality has defined and claimed this element of the present invention as clear as possible. There is nothing intrinsically wrong with how the Applicant has claimed the invention. After all, a patent applicant is free to recite features of an invention either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971). In this particular case, the recitations relating to the "Band Member" cards and the particular makeup of the "Band Member" cards are structural limitations that define the cards themselves - not the rules of the game.

2. Elrod does not anticipate claim 11.

In order for Elrod to anticipate claim 11, as required by §102, Elrod must include each and every limitation of claim 11, including the "Band Member" card limitation. Elrod discloses a game with a band theme that includes a game board with one or more paths leading to multiple performing stages, including a Final Stage, a plurality of concert platforms, a pair of dice, a series of band member tokens, a plurality of "Challenge" cards, and a plurality of "Rescue" cards. Each player selects a concert platform and advances their concert platform from the starting point to the ending point (Final Stage) by rolling the dice and following the instructions provided by the various spaces on the board (see column 2, line 10 through column 6, line 17). For example, a space may direct a player to add or remove a band member token to their

performing stage (column 11, lines 21-22). As seen in Figure 2 of Elrod, the band member tokens comprise a plurality of tokens representing generic band members, such as a singer, guitarist, drummer, etc. A space may also direct a player to pick a “Challenge” card (column 12, lines 7-8), or pick a “Rescue” card (column 12, lines 7-8). In any event, at the end of Elrod’s game, the player at the Final Stage with the most money wins.

The “Challenge” cards in Elrod “allow players to challenge themselves (SELF-CHALLENGE cards only) or their opponents to perform some task” (column 11, lines 49-51). Exemplary “Challenge” cards are detailed in column 8, line 32 through column 10, line 16. The “Rescue” cards in Elrod “enable players to name alternative musical artists as needed when beginning a turn. Rescue 126 cards also afford players the opportunity to fend off challenges and avoid other troublesome situations” (column 11, lines 51-55). Exemplary “Rescue” cards are detailed in column 7, line 38 through column 8, line 31. While it may be argued that the “Challenge” cards of Elrod are similar to the “Consequence” cards of the present invention, it is clear that neither the “Challenge” cards nor the “Rescue” cards of Elrod relate in any way to the “Band Member” cards of the game claimed in claim 11. Further, nothing in Elrod suggests or discloses a deck of “Band Member” cards that “include a plurality of groups of cards with each group of cards representing a band and the members of a band,” as claimed in claim 11. As such, Elrod cannot anticipate claim 11.

3. Elrod does not anticipate claim 14.

Claim 14, which depends from claim 11, is as follows:

The game board and game of claim 11 wherein the network of paths includes an outer path that extends around the game board; at least one intermediate path that includes an outer path that extends

around a portion of the game board and is disposed inwardly of the outer path; a generally curved path that extends in a curved fashion around at least a portion of the performing stage; and a series of feeder paths that extend from an intermediate path to the generally curved shaped path that curves around at least a portion of the performing stage.

The §102 rejection of claim 14 is improper. The Examiner does not support, or even discuss, the rejection of claim 14 under §102 in view of Elrod in the Final Office Action or in any previous office action, as required by 37 C.F.R §1.104. Because the Examiner failed to establish a *prima facie* case of anticipation, the §102 rejection is improper.

Notwithstanding, as seen in Figure 1 of Elrod, Elrod's game board includes two main paths: (1) an outer path defined by spaces 1-118 and (2) an alternate path defined by spaces 50A-55A. At best it must be agreed that the outer path and the alternate path of Elrod's game board correspond to the outer path (116) and the intermediate path (118) of the present invention. Because Elrod does not disclose a generally curved path (such as Applicant's path 140) or the series of feeder paths (such as Applicant's feeder paths 120) claimed in claim 14 and described on pages 3-6 of the specification, Elrod cannot anticipate claim 14.

Assuming, *arguendo*, that the portion of Elrod's outer path defined by spaces 110-118 represents a generally curved path that extends in a curved fashion around a portion of the performing stage, the Elrod game board still does not include any "feeder paths" as claimed in claim 14. Therefore, Elrod does not anticipate claim 14.

Conclusion

For the above stated reasons, claims 11 and 14 of the present invention define patentable subject matter and certainly define over Elrod. Accordingly, Applicant requests that the Board of Patent Appeals and Interferences reverse the Examiner and find that claims 11 and 14 are patentable.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By: *Larry L Coats/sks*

Larry L. Coats
Registration No. 25,620

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

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(9) APPENDIX

Claims

1. A game board and game, comprising:

- (a) a game board having a starting area, a network of irregular paths that lead from the starting area; and a central performing stage located generally centrally on the game board and connected to at least one segment of the network of paths;**
- (b) the network of paths including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment;**
- (c) a series of tokens provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;**
- (d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;**
- (e) a supply of money that during the course of the game is distributed to the players;**
- (f) a deck of "Consequence" cards that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;**
- (g) a deck of "Band Member" cards with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;**
- (h) a series of "Band Equipment" cards with each card designating band equipment; and**

(i) wherein the object of the game is for each player to advance his or her token along the network of paths and reach the central stage with a predetermined number of one group of "Band Member" cards and a "Band Equipment" card.

2. The game board and game of claim 1 wherein the game board is provided with a threshold destination at a point along one of the segments that make up the network of paths and wherein a player is entitled to purchase a "Band Equipment" card upon reaching the threshold destination.

3. The game board and game of claim 2 wherein the threshold destination lies on an increment along one of the paths of the network of paths and whereupon a player is permitted to purchase a "Band Equipment" card at one price when he or she lands on the increment having the threshold destination, and to purchase a "Band Equipment" card at a higher price if the player advances past the increment having the threshold destination and does not, in fact, land on the increment having the threshold destination.

4. The game board and game of claim 3 wherein the threshold destination is designated as a pawn shop.

5. The game board and game of claim 1 wherein the tokens comprise a series of miniature buses.

6. The game board and game of claim 1 wherein the group of "Band Member" cards are color coded such that each group may be distinguishable by color.

7. The game board and game of claim 1 wherein the network of paths include a curved shaped path that extends at least partially around the performing stage.

8. The game board and game of claim 7 wherein the network of paths include a series of feeder paths that feed into the curved shaped path that at least partially surrounds the performing stage.

9. The game board and game of claim 8 wherein the network of paths include an outer loop path that extends around the game board.

10. The game board and game of claim 9 wherein the network of paths include a series of intermediate paths that lie inwardly of the outer loop path and wherein the curved shaped path that at least partially surrounds the performing stage lies inwardly of the intermediate paths and wherein the feeder paths extend between one or more intermediate paths and the curved shaped path that at least partially surrounds the performing stage.

11. A game board and game comprising: a game board having a performing stage and a network of paths including a plurality of paths that lead to the performing stage; a series of tokens for being advanced from a starting point along paths along the network of paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include "Consequence" cards that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards

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are "Band Member" cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members.

12. [cancelled]

13. The game board and game of claim 11 further including a third deck of the "Band Equipment" cards and wherein a further object of the game is to arrive at the performing stage with a "Band Equipment" card.

14. The game board and game of claim 11 wherein the network of paths includes an outer path that extends around the game board; at least one intermediate path that extends around a portion of the game board and is disposed inwardly of the outer path; a generally curved path that extends in a curved fashion around at least a portion of the performing stage; and a series of feeder paths that extend from an intermediate path to the generally curved shaped path that curves around at least a portion of the performing stage.

15. The game board and game of claim 1 including a supply of money that is distributed to the players and wherein during the course of the game the players exchange the money, or collect or pay money according to increments designated on the game board.